

## REMARKS

The Final Office Action of December 23, 2005 has been reviewed and the comments therein were carefully considered. Claims 1-35 are pending in the instant application. Claims 1-35 stand rejected. No new matter has been introduced into the application.

### **Rejections under 35 USC §103**

Claims 1, 2, 5, 7, 9, and 16-21 are rejected under 35 USC §103(a) as being unpatentable over Tada et al. (hereinafter "Tada"), U.S. Patent No. 5,745,745 patented 4/28/1998, in view of Fontaine, et al. (hereinafter "Fontaine"), U.S. Patent No. 5,228,121 patented 7/13/1993. Applicants respectfully traverse these rejections.

Applicants submit that claim 1 is allowable over the cited documents for at least the following reasons. The combination of *Tada* and *Fontaine* fails to teach at least the claimed element of "separating the tag from the content with a separation variable" as recited in step (a) of claim 1. (Emphasis Added). The Final Office Action states and Applicants agree that "... Tada does not teach combining the alias and the flag and separating the combination from the content with a separation variable." (Emphasis Added; Final Office Action, Page 3.) The Final Office Action relies on *Fontaine* in an attempt to disclose this missing claimed element, stating:

Fontaine does teach combining two or more tags or information objects into a single nested structure in col. 4 lines 31 – col. 5 line 44 and col. 5 line [sic]. Since, the nested structures of Fontaine logically define the order of a document and the informational objects contained within the document, the boundaries of the combined structure encapsulating the alias and flag of Tada would have been separation variables separating the encode tag structure from the content.

Final Office Action, page 3. However, Applicants respectfully disagree, as combining tags and information objects does not disclose the claimed feature of "separating the tag from the content with a separation variable." The boundaries of a structure may not be equated with the insertion of a separation variable. In fact, if the boundaries of *Fontaine* were discernable then the need for a separation variable would not be necessary.

In addition to and different from the boundaries argument discussed by the Examiner on Page 3 of the Final Office Action, the Examiner on pages 15-16 offers a specific example from

*Fontaine* in which the Examiner alleges that the symbols %% used in the *Fontaine* preferred embodiment represent Applicants claimed separation variable. In particular, the Examiner states:

Fontaine teaches an[d] [sic] example tag named "tagname" in col. 4 line 59. Since this tag cannot be distinguished from the content, a separation variable is plainly shown also in col. 4 line 59. In the example of Fontaine, the variable %% is used to separate the tag from the text content. The separation variable enables Fontaine to identify the tag and invoke its definition which is described in col. 4 lines 49-55. Therefore, the Examiner maintains the position that Fontaine does teach the claimed separating a tag from content with a separation variable.

Applicants respectfully submit that the instructions symbolized by %% symbols used in Fontaine do not disclose, teach, or suggest the claimed feature of "separating the tag from the content with a separation variable." In particular, Fontaine at Column 4, lines 49-55 states:

The tag definition is initiated with an instruction "tag tagname". Following the tagname, the contents of the information object or tag is stored. Once the tag definition is complete, the instruction "endtag" is entered. The tag contents may then be retrieved through any desired compiler or retrieval implementation. For example, in the preferred embodiment the information (tag) is recalled through the instruction "%tagname%".

As may be seen in the cited portion of Fontaine, an information object (tag) is recalled through instruction "%tagname%". The symbols %% used in Fontaine refers to a recall instruction and do not disclose, teach, or suggest Applicants claimed "separation variable."

Support for Applicants claimed separation variable may be found on at least page 17 of Applicants specification:

At step 410, a code character is inserted to separate markup language from the actual content of the e-book file. For example, the code may be a Unicode character 0x0000. The Unicode character is inserted before and after each start and end tag. Subsequent encoding of the markup (discusses herein) should be constrained so that the Unicode character 0x0000 never occurs within the representation of a start or end-tag or elsewhere within the content, but rather occurs only as a first and last character of each start and end tag.

As neither *Tada* nor *Fontaine* disclose the claimed feature of "separating the tag from the content with a separation variable," independent claim 1 is patentable over the combination for at least this reason.

In addition, claim 1 is allowable over *Tada* and *Fontaine* for at least one additional reason. The combination of *Tada* and *Fontaine* fails to teach at least the claimed element of “replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag” as recited in step (b) of claim 1. The Final Office Action relies on *Tada*, contending that “Tada teaches replacing the tag with an alias in col. 22 lines 6-20.” Final Office Action, page 3. Col. 22 lines 13-28 of *Tada* states:

A logical structure identification number corresponding to the logical structure discriminator is obtained from the correspondence table . . . . Specifically, in the example . . . the start tag '<Title>' is detected, . . . and the logical structure identification number '1' is obtained . . . .

. . . At the search database creation step 35, in place of the start tag, a specific control code “α” representative of the start of the logical structure is written and the obtained logical structure identification number and logical structure length are written after the control code

At no point in these lines does *Tada* describe “replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag” as recited in the claim. Rather, this portion of *Tada* merely describes obtaining an identification number, the identification number replacing logical structure discriminator (such as “a character string after the start character “<” and before the end character “>”). Col. 22, lines 10-11. Applicants respectfully submit that identification number in *Tada* is replacing content such as “a character string” and is not replacing a tag with an alias, the alias being a pre-defined representation for the tag. Moreover, as stated above in *Tada*, a start tag is replaced by a control code “α”. Applicant respectfully submits that replacing a start tag with control code does not disclose, teach, or suggest, the claimed feature of “replacing the tag, with an alias, wherein the alias is a pre-defined representation for the tag.” (Emphasis Added).

Furthermore, claim 1 is allowable over *Tada* and *Fontaine* for at least another reason. The combination of *Tada* and *Fontaine* fails to teach or suggest “inserting at least one flag within the tag to form an encode tag structure” as recited in step (c) of claim 1. The Final Office Action relies on *Tada*, contending that “Tada teaches in col. 22 line 24 – col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not.” Final Office Action, page 3. Col. 22 lines 24-29 states:

[I]n place of the start tag, a specific control code “α” representative of the start of the logical structure is written and the obtained logical structure identification number and logical structure length are written after the control code “α”. The end tag is

deleted, and the control codes such as text ID and eot are written for the creation of the search database.

More explicitly, col. 22 lines 36-37 state that “the start tag is replaced by the control code  $\alpha$  . . .” Therefore, *Tada* teaches replacing the tag with the control code. If the control code is a flag as the Final Office Action claims, then *Tada* does not teach or suggest “inserting at least one flag within the tag to form an encode tag structure” as recited in the claim. Rather, this portion of *Tada* would teach replacing the tag with the flag. Therefore for at least this additional reason, Applicants respectfully submit that claim 1 is in condition for allowance.

Finally, Applicants submit that the motivation to combine *Tada* and *Fontaine* is improper. The Final Office Action on page 3 states:

It would have been obvious and desirable to have combined the alias and flag of Tada into a single structure in the form of a document object as taught by Fontaine so that the information would have retained a document format as is taught by Fontaine as opposed to the database format explicitly taught by Tada. Thus, by retaining a document format, the content could be manipulated and used as a document.

Furthermore, the Final Office Action on page 16 states:

Tada uses the created structure to improve the search of text content, as is a similar goal of the invention of claim 1. Fontaine teaches an improvement for separating a take from text context. The improvement of Fontaine would have enabled the tag search improvement of Tada to have been implemented in the document. Fontaine teaches placing and separating the tags within the text content directly in col. 4 lines 57-63. Thus, the Examiner believes this improvement to have been created by one of ordinary skill in the art at the time of the invention by expressly using the stated advantages of Tada and Fontaine.

Applicants respectfully submit that the offered motivation to combine the teaching of *Tada* and *Fontaine* cannot be found in neither *Tada* nor *Fontaine* or in the knowledge of one of ordinary skill in the art at the time of the invention. It is respectfully submitted that just because the teaching of different documents may be combined and implemented together, it may not be inferred that such motivation existed at the time of the invention by those of ordinary skill in the art. Applicants respectfully submit that the Examiner is using the present application as a blueprint to combine references when the only suggestion can be found in the present application. Therefore, for at least the reasons describe above, Applicants respectfully submit that claim 1 is in condition for allowance.

Dependent claims 2-9 which ultimately depend from claim 1 are allowable for at least the same reasons as independent claim 1.

Claim 16 also stands rejected under *Tada* in view of *Fontaine*. Applicants submit that this claim is allowable because the combination of *Tada* and *Fontaine*, even if proper, fails to teach or suggest the claimed features of claim 16. Applicants respectfully traverse the rejections.

Applicants submit that claim 16 is allowable over the cited art for at least the following reasons. The combination of *Tada* and *Fontaine* fails to teach at least the claimed element of "inserting at least one code character into the electronic document to separate markup language from content" as recited in step (a) of claim 16. The Final Office Action relies on *Fontaine* for teaching this claimed element. The Final Office Action states:

*Fontaine* teaches combining tags and information objects into a single nested structure in col. 4 line 31 – col. 5 line 44 and col. 5 line [sic]. Since, the nested structures of *Fontaine* logically define the order of a document and the informational objects contained within the document, the boundaries of the structure encapsulating the alias of *Tada* would have been separation variables separating the encode tag structure from the content.

Final Office Action, page 4. However, Applicants respectfully disagree, as combining tags and information objects does not disclose the claimed feature of claim 16. The boundaries of a structure may not be equated with the insertion of at least one code character. In fact, if the boundaries of *Fontaine* were discernable then the need for a separation variable would not be necessary.

In addition to and different from the boundaries argument discussed by the Examiner on Page 4 of the Final Office Action, the Examiner on page 17 offers a specific example from *Fontaine* in which the Examiner alleges that the symbols %% used in the *Fontaine* preferred embodiment represent Applicants claimed separation variable. (We note that the Examiner must be refereeing to the claimed "at least one code character" as a separation variable is not claimed in independent claim 16). In particular, the Examiner states:

*Fontaine* teaches an[d] [sic] example tag named "tagname" in col. 4 line 59. Since this tag cannot be distinguished from the text content, a separation variable is plainly shown also in col. 4 line 59. In the example of *Fontaine*, the variable %% is used to separate the tag from the text content. The separation variable enables *Fontaine* to identify the tag and invoke its definition which is described in col. 4 lines 49-55.

Therefore, the Examiner maintains the position that Fontaine does teach the claimed separating a tag from content with a separation variable.

Applicants respectfully submit that the instructions symbolized by %% symbols used in Fontaine do not disclose, teach, or suggest the claimed feature of "inserting at least one code character into the electronic document to separate markup language from content." In Fontaine, an information object (tag) is recalled through instruction "%tagname%". The symbols %% used in Fontaine refers to a recall instruction and do not disclose, teach, or suggest Applicants claimed "at least one code character."

Moreover, the combination of *Tada* and *Fontaine* fails to teach at least the claimed element of "replacing the tag with an alias, whereby the tag may be readily identified during run-time parsing of the document" as recited in step (d) of claim 16. The Office Action relies on *Tada*, contending that "Tada teaches replacing the tag with an alias whereby the tag may be readily identified during run-time parsing of the document in col. 22 lines 6-20."

As discussed with respect to claim 1, at no point in these lines does *Tada* describe "replacing the tag with the alias" as recited in the claim. Rather, this portion of *Tada* merely describes obtaining an identification number, the identification number replacing logical structure discriminator (such as "a character string after the start character "<" and before the end character ">"). Col. 22, lines 10-11. Applicants respectfully submit that identification number in *Tada* is replacing content such as "a character string" and is not replacing a tag with the alias." Moreover, as stated above in *Tada*, a start tag is replaced by a control code "α". Applicant respectfully submits that replacing a start tag with control code does not disclose, teach, or suggest, the claimed feature of "replacing the tag with the alias."

Therefore, for at least these reasons, Applicants submit that claim 16 is in condition for allowance. Dependent claims 17-18 which ultimately depend from claim 16 are allowable for at least the same reason as independent claim 16.

Claim 19 also stands rejected under *Tada* in view of *Fontaine*. The Final Office Action alleges that "Tada teaches a tag having encoded therein a predefined integer alias for the tag in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20" as recited in step (a) of claim 19. Final Office Action, page 5. Applicants respectfully traverse this rejection.

The cited portion of *Tada* does not describe “at least one tag having encoded therein a predefined integer alias for the tag.” Rather, *Tada* describes obtaining a logical structure identification number corresponding to the logical structure discriminator. In fact, *Tada* describes that “in place of the start tag, a specific control code ‘ $\alpha$ ’ representative of the start of the logical structure is written and the obtained logical structure is written and the obtained logical structure identification number and logical structure length are written after the control code ‘ $\alpha$ ’ It is respectfully submitted that the Final Office Action does not address the claimed element of “at least one tag having encoded therein a predefined integer alias for the tag.”

In addition, claim 19 is allowable for at least an additional reason. Claim 19 recited the claimed feature of “a code separating the tag from the content portion, whereby the content and markup within the document may be readily parsed at run-time.” The combination of *Tada* and *Fontaine* fails to teach at least this claimed feature as discussed above. Therefore, for at least these reasons, Applicants submit that claim 19 is in condition for allowance. Claims 20-23 which ultimately depend from claim 19 are also allowable as being dependent on an allowable base claim.

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tada* in view of *Carus et al.* (hereinafter “*Carus*”), U.S. Pat No. 6,035,268 provisional filed 8/22/1996. Applicants respectfully traverse these rejections.

Applicants submit that claim 10 is allowable over the cited art for at least the following reasons. The combination of *Tada* and *Carus* fails to teach at least the claimed element of “determining whether the tag is within a single word” as recited in step (b) of claim 10. The Final Office Action admits and Applicants agree that “*Tada* does not teach comparing a left and right term to determine if they are part of a single word.” Final Office Action, page 10. The Final Office Action relies on *Carus*, contending that “*Carus* does teach comparing a left and right term to determine if they are part of a single word . . . in col. 2 line 62 – col. 3 line 31 and col. 5 lines 51-67.” Final Office Action, page 10. Furthermore, the Final Office Action on page 19 states:

*Carus* teaches identifying a position and determining whether it is between words or within a word in col. 5 lines 51-67. Therefore, it provides the teaching of determining whether a tag is within a single word.”

The Applicants respectfully disagree because *Carus* describes a structure in which “[t]he associated character-transition tag identifies the existence of a concatenation between successive characters, a break between successive characters, or an unknown transition between successive characters.” *Carus*, col. 3 lines 28-32. The determination of a break between successive characters does not disclose, teach, or suggest the claimed feature of “identifying a tag between a left and a right term within a document.” Claim 10 provides a “method for pre-computing an electronic document having markup language content comprising the steps of . . . determining whether the tag is within a single word,” whereas *Carus* describes a structure where tags themselves identify a concatenation, break, or transition. Therefore, for at least these reasons, Applicants submit that claim 10 is in condition for allowance. Dependent claim 11 which ultimately depends from claim 10 is allowable for at least the same reason as independent claim 10.

Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tada*. Applicants respectfully traverse these rejections.

Applicants submit that claim 12 is allowable over the cited art for at least the following reasons. *Tada* fails to teach at least the claimed element of “if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion, whereby a no search field may be readily identified and skipped during a run-time linear search” as recited in step (c) of claim 12. The Final Office Action contends that “*Tada* teaches in col. 22 line 24 – col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not.” Final Office Action, page 11. However, *Tada* actually compares two identification numbers to determine if the “matching process skip step is executed,” and when the numbers do not match, “the text . . . is not read and is discarded.” *Tada*, col. 22 line 53 – col. 23 line 3. Therefore, *Tada* teaches that it is the comparison between identification numbers that indicates whether the text is read, not the flag.

In addition, claim 12 is allowable over *Tada* for at least one additional reason. The Final Office Action admits and Applicants agree that “*Tada* does not teach that the no search flag is conditionally inserted based on determining whether the portion is to be displayed for viewing by a reading device.” Final Office Action, page 11. Rather, the Final Office Action contends that:



It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified *Tada* to have created the claimed invention. It would have been obvious and desirable to have used the search exclusion technique of *Tada* to have excluded portions which are not to be displayed by a viewing device from searching. This would have corresponded to the goal of *Tada* of improving run-time search operations as described in col. 6 lines 30 – col. 7 line 20.

Applicants respectfully disagree. The Final Office Action discloses no teaching or suggestion for the modification of *Tada* to insert a no search flag. Rather, *Tada* teaches and suggests the aforementioned comparison method. Thus, Applicants submit that claim 12 is in condition for allowance for at least these reasons. Dependent claim 13 which ultimately depends from claim 12 is allowable for at least the same reason as independent claim 12.

Claims 14 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereinafter “*Open eBook*”) published 9/16/1999. Applicants respectfully traverse these rejections.

Applicants submit that claim 14 is allowable over the cited art for at least the following reason. *Open eBook* does not disclose, teach, or suggest the claimed feature of “replacing *part* of the URL with the reference string and a flag for the file.” (Emphasis added). Thus, Applicants submit that claim 14 is in condition for allowance for at least this additional reason. Dependent claim 15 which ultimately depends from claim 14 is allowable for at least the same reason as independent claim 14.

Claims 24-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Open eBook* in view of *Tada*. Applicants respectfully traverse these rejections.

Claim 24 recites the claimed features of “wherein the content file is pre-computed and encoded to minimize computational run-time requirements.” The Final Office Action states and Applicants agree that *Open eBook* does not teach wherein the content file is pre-computed and encoded to minimize run-time requirements. Final Office Action, Page 13. The Final Office Action states that *Tada* teaches the advantage of decreased search time as a result of pre-computing and encoding the content file. In addition, the Final Office Action states:

It would have been obvious and desirable to have used the content file pre-computing and encoding as taught by Tada to have enabled fast run-time search operations on a Open eBook, when is often implemented on a low power portable reading device.

Final Office Action, Page 13.

Applicants respectfully disagree. Neither reference discloses or suggests this motivation to combine. It is respectfully submitted that just because the teaching of different documents may be combined and implemented together, it may not then be inferred that such motivation existed at the time of the invention by those of ordinary skill in the art. Therefore, Applicants submit that independent claim 24 is allowable. Claims 25-31 depend from claim 24 and are also allowable as being dependent on an allowable base claim and further in view of additional claimed features recited therein.

Claim 32 is also stands rejected under *Open eBook* in view of *Tada*. Applicants respectfully traverse this rejection.

Claim 32 recites the claimed features of "forming a converted document. . . ." The Final Office Action states and Applicants agree that "Open eBook does not teach converting a document in a first format by processing the document to pre-compute and encode the markup language within the document. . . ." Final Office Action, Page 14. The Final Office Action states that *Tada* teaches converting a document in a first format by processing the document to pre-compute and encode the markup language within the document. Final Office Action, Page 15. In addition, the Final Office Action states:

It would have been obvious and desirable to have used the document and pre-computing and encoding as taught by Tada to have enabled fast run-time search operations on a Open eBook, when is often implemented on a low power portable reading device.

Final Office Action, Page 15.

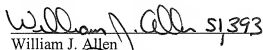
Applicants respectfully disagree. Neither reference discloses or suggests this motivation to combine. It respectfully submitted that it is impermissible to use the present application as a blueprint to combine references when the only suggestion can be found in the present application. It is respectfully submitted that just because the teaching of different documents may be combined and implemented together, it may not then be inferred that such motivation existed at the time of the

invention by those of ordinary skill in the art. Therefore, for at least this reason, the combination of Open eBook and *Tada* fails to support an obviousness-type rejection for independent claim 32. Claims 33-35 depend from independent claim 32 and are allowable for at least the reason discussed above with regards to independent claim 32.

Applicants respectfully submit that the instant application is in condition for allowance. Should the Examiner believe that a conversation with Applicant's representative would be useful in the prosecution of this case, the Examiner is invited and encouraged to call Applicant's representative.

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Respectfully submitted,

  
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